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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/535,306	02/17/2006	Jean Beguinot	Q88031	3704
23373	7590	03/09/2009	EXAMINER	
SUGHRUE MION, PLLC			YEE, DEBORAH	
2100 PENNSYLVANIA AVENUE, N.W.				
SUITE 800			ART UNIT	PAPER NUMBER
WASHINGTON, DC 20037			1793	
			MAIL DATE	DELIVERY MODE
			03/09/2009	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/535,306	BEGUINOT ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Deborah Yee	1793	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 27 February 2009.

2a) This action is **FINAL**.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-19 is/are pending in the application.

4a) Of the above claim(s) 6-19 is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-5 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.

5) Notice of Informal Patent Application

6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

1. Amendment filed February 27, 2009 has been entered

### ***Election/Restrictions***

2. Claims 6 to 19 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim.

### ***Response to Arguments***

3. Applicant's arguments filed February 27, 2009, with respect to the rejection(s) of claim(s) 1 to 5 under 35 USC 103(a) as being unpatentable over Japanese patent 403031443 or Japanese patent 06017188 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration and updated search, a new ground(s) of rejection is made.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1 to 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 4,437,903 ("Furukawa") or Japanese patent 2000-355735 ("JP-735").

6. Claims 1 to 5 in columns 5-6 of Furukawa and the English abstract of JP-735, each disclose steel having a composition with constituents whose wt% ranges overlap those recited by the claims; and such overlap establishes a prima facie case of

obviousness because it would be obvious for one skilled in the art to select the claimed alloy wt% ranges over the broader disclosure of the prior art because the prior art teaches similar utility (using steel to make structural component) and the same microstructure comprising martensite and/or bainite and residual austenite, see MPEP 2144.05.

7. Even though the equations recited by the claims are not taught by prior art, such would not be a patentable distinction. Note that it has been well settled that there is no invention in the discovery of a general formula if it covers a composition described in the prior art, *In re Cooper and Foley* 1943 C.D. 357,553O.g. 177; 57 USPQ 117, *Taklatwalla v. Marburg*, 630 O.G. 685, 1949 C.D. 77 and *In re Pilling*, 403 O.G. 513, 44F (2) 878, 1931 C.D. 75. Also in the absence of evidence to the contrary, the selection of the proportion of elements would appear to require no more than routine investigation by those of ordinary skilled in the art. *In re Austin, et al.*, 149USPQ 685, 688. In the instant case, since the concentration of each element in prior art overlaps the claimed concentration of the corresponding element, then the claimed equations would have been expected to be met in prior art.

8. More specifically, steel 1 in table 1 of column 5 of Furukawa and steel examples in table 1, 3, and 6 meet or closely approximate the claimed composition and equation.

9. For the foregoing reasons, claims would not patentably distinguish over prior art.

***Allowable Subject Matter***

10. Claims 3 and 4 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

11. The following is a statement of reasons for the indication of allowable subject matter: Claims 4 and 5 recite  $\%Cr + 3(\%Mo + \%W/2) \geq 1.8$  or 2.0, which is not taught or suggested by the art of record. Note Furukawa does not contain Cr, Mo or W; and JP-735 in claim 5 teaches Cr and Mo in the range of 0.3% or less.

12. Claims 14, 15, 18 and 19, drawn to the non-elected invention of making weldable component of structural steel which includes all the limitations of product claims 4 and 5 will be rejoined and examined in accordance with MPEP 821.04.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deborah Yee whose telephone number is 571-272-1253. The examiner can normally be reached on monday-friday 6:00 am-2:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on 571-272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Deborah Yee/  
Primary Examiner  
Art Unit 1793

/DY/